

New Claim 32 has been added to define the detection apparatus relating to step (c) of amended Claim 1. Support for new Claim 32 is found in the specification at page 18, lines 16-23 and at page 19, lines 1-2.

Applicants respectfully submit that the amendment of the specification, the cancellation of Claims 2 and 5-31 and the amendment of Claims 1, 3 and 4 have been made in good faith and no new matter has been added.

**a.     §121; Election/Restriction**

The Examiner has requested a restriction to one of the following inventions under 35 U.S.C. §121:

- I.     Claims 1-16, drawn to a method for identifying a container, classified in class 436, subclass 165.
- II.    Claims 17-31, drawn to a uniquely identifiable container, classified in class 206, subclass 459.1 or class 422, subclass 915.

A provisional election was made without traverse to prosecute the invention of Group I, Claims 1-16 by telephone with Nanette Thomas on January 6, 2000.

Affirmation of this election is made herewith whereby Group I, Claims 1-16 are elected and Group II, Claims 17-31 are withdrawn from consideration. However, applicants maintain the right to file a divisional or continuation application for the non-elected subject matter of Claims 17-31.

**b.     Specification**

The disclosure has been objected to because of the following information:

On page 11, line 14, the reference number "24" describing a container should be "20".

Applicants respectfully submit that with the amendment of the specification the objection is no longer applicable.

Reconsideration and withdrawal of the objection is respectfully requested.

c. **Claims**

Claims 1-6 have been objected to because of the following informalities:

Claim 1, the phrase "as part of its manufacture locating said biological sample in said container" is unclear. To obviate this objection, the Examiner suggests placing -- and -- or a comma after the word "manufacture".

Claims 5 and 8 are of improper dependent form for failing to further limit the subject matter of a previous claim. To obviate this objection, the Examiner suggests changing the dependence from "claim 1" to "claim 2" and "claim 6" to "claim 7", respectively.

Claim 9, the word "adjacent" should be followed by the word "to".

Applicants respectfully submit that with the amendment of the Claims, the objection is no longer applicable.

Reconsideration and withdrawal of the objection is respectfully requested.

d. **§102(b); Kavanaugh**

Claims 1-3, 7-11 and 16 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,683,786 to Kavanaugh.

The Examiner states that Kavanaugh teaches identifying a biological sample container (microscope slide) comprising the steps of:

- (a) obtaining a container (slide 10) having an outer surface;
- (b) providing a container (slide 10) with a unique identifier where the specular reflectance differs and where the method of providing the identifier is by laser etching;
- (c) detecting and sensing light reflected by container (bar code scanner);
- (d) associating the identifier with information pertaining to use or planned use of the container, as recited in the instant invention (FIGS. 3, 5-6; col. 1; line 66, col. 2, line 14; col. 3, lines 25-60).

Applicants respectfully traverse the rejection and submit that a container is not a slide and that amended and remaining Claims 1, 3 and 4 of the present invention are not anticipated by Kavanaugh.

Applicants respectfully submit that Kavanaugh discloses a microscope slide having a glass plate, a marking surface coating on an area of the glass plate and indicia formed by etching away portions of the marking surface coating.

Applicants respectfully submit that the present invention as recited in amended Claim 1 is a container comprising certain attributes that are different from a microscope slide. In addition, the present invention recites a specular reflectance that is different from the marking surface and indicia of Kavanaugh.

Applicants respectfully submit that for the claim to be anticipated by a reference under 35 U.S.C. §102(b), every element of the claimed invention must be identically shown in a single reference and arranged as in the claims under review.

Applicants respectfully submit that the claimed invention is different from that disclosed in Kavanaugh.

In addition, applicants respectfully submit that with the amendment of Claim 1, Claim 1 now more particularly recites the present invention and the rejection is no longer applicable.

Reconsideration and withdrawal of the rejection is respectfully requested.

e. **§103(a): Kavanaugh in view of DeRossett, Jr.**

Claims 1-3, 7-11 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,683,786 in view of U.S. Patent No. 4,985,115 to DeRossett, Jr.

The Examiner states that it would have been obvious to one of ordinary skill in the art to apply the teachings of Dr. Rossett, Jr. to Kavanaugh if unobstructed view is desired.

The Examiner states that Kavanaugh teaches identifying a biological sample container (microscope slide) comprising the steps of:

- (a) obtaining a container (slide 10) having an outer surface;
- (b) providing a container (slide 10) with a unique identifier where the specular reflectance differs (specular reflectance of etching is less than adjacent areas) and where the method of providing the identifier is by laser etching.
- (c) detecting and sensing light reflected by container (bar code scanner); and
- (d) associating the identifier with information pertaining to use or planned use of the container, as recited in instant invention (FIGS. 3, 5-6; col. 1; line 66 – col. 2, line 14; col. 3, lines 25-60).

The Examiner further states that Kavanaugh fails to teach where the specular reflectance is greater than adjacent areas and DeRossett, Jr. teaches highlighting etched glass by embedding the etching with epoxy for greater specular reflectance.

Applicants respectfully traverse the rejection and submit that amended and remaining Claims 1, 3, 4 and 32 of the present invention are unobvious over Kavanaugh in view of DeRossett, Jr. and that a prima facie obviousness rejection has not been made.

Applicants respectfully submit that the present invention as recited in remaining Claims 1, 3, 4 and 32 is a method of identifying a biological sample associated with a plastic container, not a microscope slide, comprising a unique identifier that has a greater specular reflectance than the outer wall surface of the container.

Applicants respectfully submit that Kavanaugh teaches a microscopic slide system and DeRossett, Jr. teaches a method for etching glass. Applicants respectfully submit that in view of the many differences between the documents cited and the present invention as presented above, applicants respectfully request reconsideration and withdrawal of the rejection.

**f. §103(a): Kavanaugh and DeRossett, Jr. and further in view of Handly and Richman**

Claims 4-6 and 12-15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,683,786 in view of U.S. Patent No. 4,985,115 to DeRossett, Jr. and further in view of U.S. Patent No. 5,397,410 to Handly and U.S. Patent No. 5,801,356 to Richman.

It is the Examiner's position that it would have been obvious to one of ordinary skill in the art to apply the teachings of either Handly or Richman as a means of marking glassware because both are well known in the art as alternative means to the expensive

and costly laser etching. The Examiner also states that it would have been also obvious to use melting as a means to engrave an identifier on a container if the container is plastic instead of glass.

The Examiner states that Kavanaugh and DeRossett, Jr. are silent about using alternative means for marking a container besides etching with a laser, that Handly teaches providing an identifier by incorporating a ceramic film coating with a bar code pattern onto glassware and that Richman teaches abrading as an alternative means to laser etching letters on glass.

Applicants respectfully traverse the rejection and submit that amended, new and remaining Claims 1, 3, 4 and 32 of the present invention are unobvious over Kavanaugh in view of DeRossett, Jr. and further in view of Handly and/or Richman.

Applicants respectfully submit that the present invention as recited in remaining Claims 1, 3 and 4 and new Claim 32 is a method of identifying a biological sample associated with a plastic container, not a microscope slide, comprising a unique identifier that has a greater specular reflectance than the outer wall surface of the container.

Applicants respectfully submit that Kavanaugh teaches a microscope slide, DeRossett, Jr. teaches a method for etching glass, Handly teaches a method for making a machine readable bar code on glassware and Richman teaches laser scribing on glass.

Applicants submit that Kavanaugh does not suggest or teach a plastic container of the present invention and the other documents do not teach or suggest the specular reflectance of the present invention. Therefore, applicants respectfully submit that the documents cited would not have suggested the present invention to one skilled in the art and therefore a prima facie obviousness rejection has not been made.

Reconsideration and withdrawal of the rejection is respectfully requested.

**CONCLUSION**

Allowance of the Claims is courteously urged.

Respectfully submitted,

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<u>Nanette S. Thomas</u> (SIGNATURE)	<u>7-26-00</u> (DATE)

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